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IN THE
Supreme Court of the United States

No. 72

OCTOBER TERM 1937

CROWN CORK & SEAL COMPANY, INC., *Plaintiff-Petitioner,*

v.

FERDINAND GUTMANN & COMPANY, *Defendant-Respondent.*

BRIEF FOR PLAINTIFF-PETITIONER.

THOMAS G. HAIGHT,
GEORGE F. SCULL,
JOHN J. DARBY,
GEORGE W. PORTER.
Counsel for Plaintiff-Petitioner.

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BRIEF FOR PLAINTIFF-PETITIONER.

OPINIONS OF THE COURTS BELOW.

The opinion of the Circuit Court of Appeals is reported in 86 F. (2d) 698, and will be found in this record at Volume III, pp. 1830, 1834.

The opinion of the District Court is reported in 14 Fed. Supp. 255, and will be found in this record at Volume III, pp. 1767, 1784, 1796.

JURISDICTION.

This case is here on a writ of certiorari to the Circuit Court of Appeals for the Second Circuit under the provisions of United States Code, Title 28, Section 347. The writ was granted on October 11, 1937.

STATEMENT OF THE CASE.

This is a patent suit brought by petitioner to enjoin infringement of two¹ Letters Patent, namely, Warth Reissue Patent No. 19,117, dated March 20, 1934 (R. p 547), hereinafter identified as the "parent" patent, and Warth patent No. 1,967,195, dated July 17, 1934 (R. p. 552), hereinafter identified as the "divisional" patent.

The patents cover methods for applying a small disc of foil or paper, known as a "center spot", to the cork cushion discs of crown caps used for sealing high pressure beverages, such as beer and ginger ale. The center spot is united to the cork disc by a thermoplastic (heat softenable) adhesive, such as gutta percha.

The center spot protects the cork cushion from the sealed liquid in the manner illustrated in the opposite sketch. The spot must be centered so that its edge extends over only a portion of the width of the bottle lip, thus leaving the cork around the spot exposed for direct engagement with the lip. Exact centering of the center spot is essential to insure uniform sealing engagement of the outer edge of the lip directly with the cork around the lip, and also uniform engagement of the inner edge of the lip with the center spot to protect the sealed beverage from the cork.

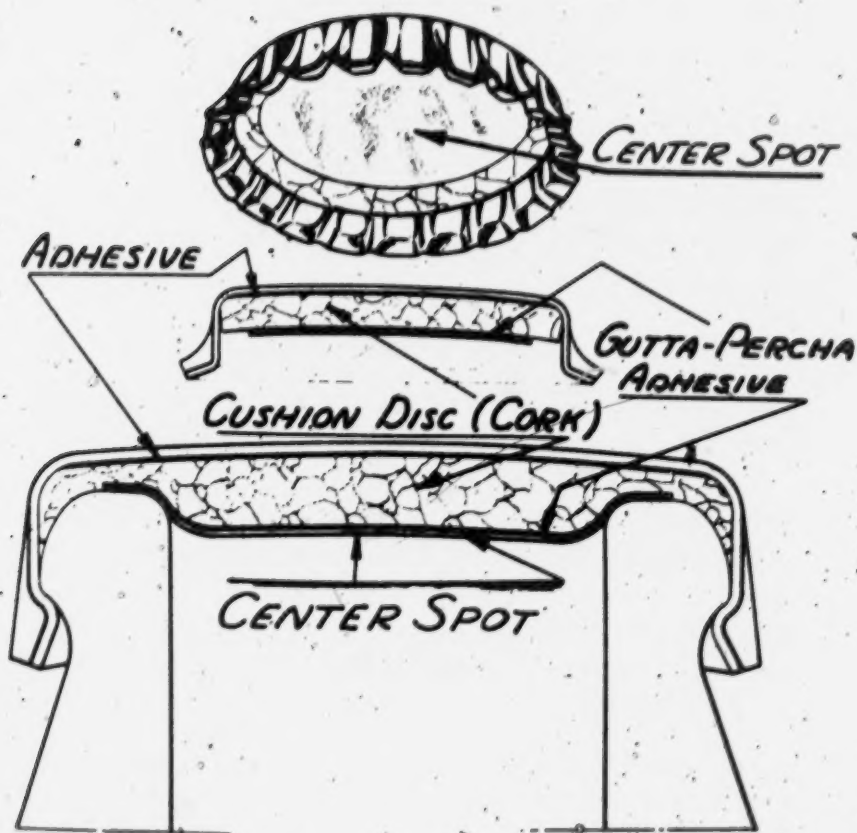
The Manufacture of Center Spot Crowns.

Closures having center spots adhesively united to the cushion disc had been known for years prior to the inventions in suit, but, aside from petitioner's own manufacture by its so-called "slide" machine,² no success had attended efforts to manufacture such a closure commercially. The problem was to adhere the spot securely *at high speed* and *accurately center it*; otherwise, the crown could not be sold in competition with other closures. An impermanently or

¹ Three other patents before the Court of Appeals are not involved here.

² Described in the Appendix, pp. 41, 42.

CENTER SPOT CROWN CAP



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inaccurately-centered spot results in spoilage of the bottle contents.

Attempts had been made to adhere center spots with liquid-softened adhesives, but without success.³ Experienced inventors had worked for years in developing and patenting machinery, but abandoned their efforts after admitted failure (R. pp. 129, 130, 344, 355).

As early as 1917, petitioner began manufacture of center spot crowns by the use of gutta percha, a thermoplastic adhesive. It used its so-called "slide" machine which was able to produce only from fifty to sixty closures a minute (R. p. 371).

This cumbersome machine presented many difficulties (R. pp. 370, 371) and the machines were subjected to continuous experiments (R. p. 371) over a period of about eight years. They were scrapped when the Warth method was developed.

The Warth Patents in Suit.

These patents disclose the method which has been used by petitioner since at least as early as 1927 (R. p. 1802) and which, as the District Court found (R. p. 1785), enabled petitioner to increase its production from less than *sixty* closures per minute for each unit by the old slide machine, to over *five hundred* closures per minute for each unit employing the Warth method. The patents describe the only method used today in the manufacture of crowns (R. p. 68) in which a center spot is adhesively united to the cork.

³ McManus patent No. 1,402,780 (R. p. 1177) and Alberti patent No. 1,401,300 (R. p. 1205). McManus was unable to manufacture at a speed higher than *forty* a minute (R. p. 344) and with about *ninety per cent defective closures*. Alberti's efforts never passed the experimental stage (R. p. 355). The District Court found (R. p. 1787) that "Men skilled in the art had long sought by various methods to accomplish what Warth teaches * * *".

The Warth Patent Reissue 19,117, March 20, 1934.

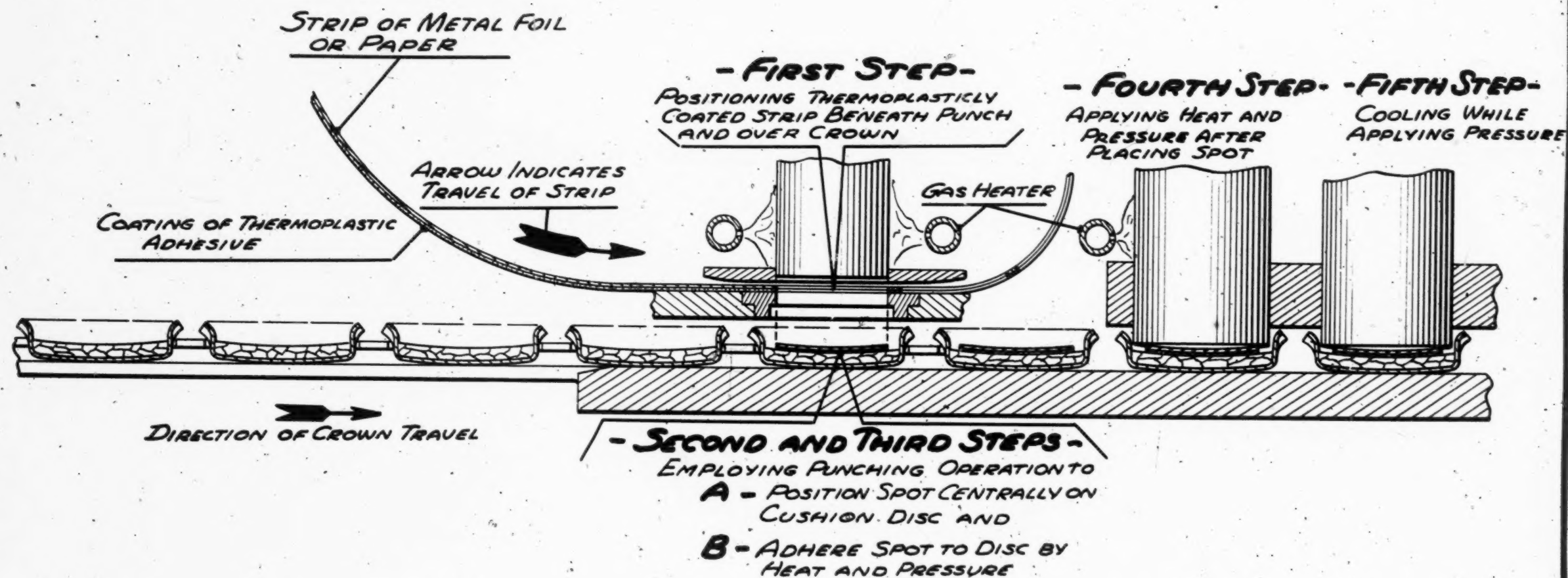
This patent discloses Warth's generic method which briefly is as follows: He positions a strip of spot material coated with non-tacky thermoplastic adhesive immediately above a traveling line of crowns and beneath a punch. The descent of the punch cuts out a spot and carries it directly down against the cork disc of a crown, heat being supplied to the spot *upon or at the instant of its contact with the cork to soften and make the adhesive tacky*. "In this way, heat and pressure are applied simultaneously to the spot at the instant of its assembly with the crown, thus insuring instantaneous adherence of the spot in its exactly-centered position. After such assembly and adherence, the crown moves to the next stage where again it may be pressed with a heated plunger. Then the spot is held under pressure while it is permitted to cool. Claim 3⁴ of the reissue patent is typical of the two claims (1 and 3) in suit and describes the generic method in formal language.

It will be noted that the claim does not specify any particular way of supplying the heat to the adhesive except that it must be supplied to the spot (1) simultaneously with pressure, and (2) "upon assembly", *i. e.*, at the instant the spot is deposited on the cork.

⁴ The improved method of manufacturing caps of the type having an interior disc of cushion material provided on its exposed face with a center spot, which comprises providing spot material in strip form having one surface formed of an exposed continuous coating of water resistant adhesive which is normally hard at room temperature but becomes tacky upon the application of heat and having another surface to be exposed to the contents of a capped container, cutting from said strip a facing spot having one surface completely coated with said adhesive with a cap disposed beneath the portion of the strip from which the spot is cut, whereby the cutting operation positions the spot upon the cushion material with the coating between the spot and the cushion material, and upon assembly applying simultaneously to the spot pressure and sufficient heat to render the adhesive tacky, thereby causing the spot to adhere to the cushion material and thereafter permitting the adhesive to cool and harden while subjecting the assembled unit to pressure.

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While the specification as originally filed, had fully disclosed the Warth generic method and had suggested various instrumentalities suitable for performing that method, no drawing was originally filed. In the prosecution of the application, the Patent Office required a drawing (R., p. 1253) of some mechanism suitable for carrying out the invention and it was supplied. Since the invention being claimed was a method, Warth needed to show, and all that he did show was some suitable mechanism by which his method could be performed.

For applying both heat and pressure to the spot at the time of assembly, Warth selected and depicted in his drawing, merely for illustrative purposes, a simple heated punch as part of what he referred to as "a suitable mechanism".

The Warth generic method, as it would be carried out with this illustrated "suitable mechanism", is shown by the drawing opposite this page.

The Warth method is essentially different from that of the old slide machine which it superseded and, as the District Court said (R. p. 1790), the combination of steps in the Warth method are not "found in the plaintiff's first old slide machine".

A description of the slide machine and the essential differences between it and the Warth method, will be found in the appendix, pp. 41, 42.

The Warth Divisional Patent No. 1,967,195, July 17, 1934.

In the generically claimed method of the parent patent, there was no limitation as to the manner in which heat was to be gotten to the spot, so long as it was at the instant of assembly with the cork cushion and simultaneously with the application of pressure by the punch. On the contrary, Warth's divisional patent is directed to a *particular way* of applying the heat to the spot. The divisional patent is, therefore, related to the parent patent as a specie is to its genus.

The method described in the divisional patent is illustrated in the drawing opposite this page. The cork discs in the crown shells are heated from above by gas jets as they advance to the spotting punch. When the assembled crowns with their preheated corks reach the punch and a spot is punched out and pressed against a cork, the heat stored in the cork passes to the adhesive simultaneously with the pressing of the spot on the cork. Consequently, at the instant of assembly, the adhesive is made tacky and this, with the pressure, causes the adherence of the spot in its exactly centered position. Thereafter, the crown may be subjected to further heat and pressure and then is cooled under pressure as described in the parent patent.

This particular way of heating the adhesive has an advantage over other ways, such as the use of a heated punch, in that less careful control of the heat is required (R. p. 412).

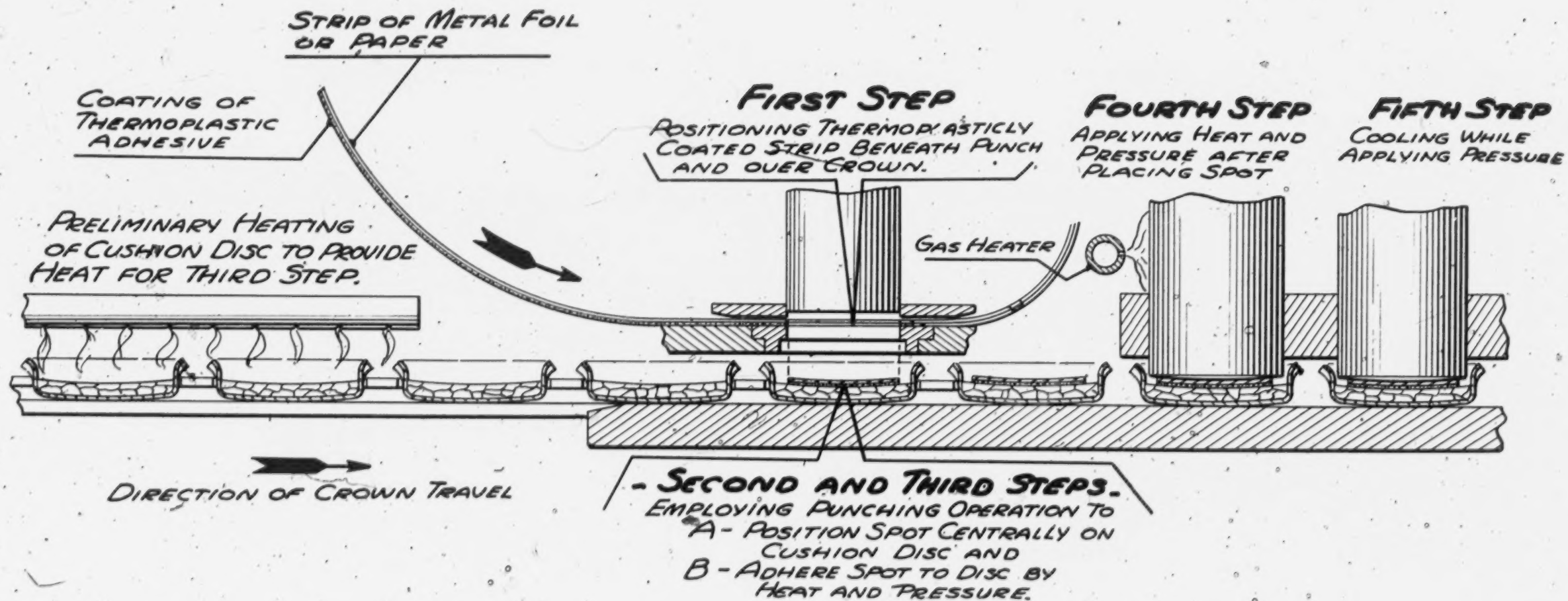
The claims of the divisional patent, of which claim 3⁵ is typical, are limited to this specific mode of heat application to the spot by the phrase "heating the pads in the caps". This language also distinguishes the claims of the divisional patent from those of the parent patent for Warth's generic invention, since the claims of the parent patent do not specify any particular method of applying the heat to the spot at the instant it is deposited.

⁵ The method of assembling linings for sealing pads in receptacle closure caps, consisting in providing caps with sealing pads therein and a web of lining material arranged with an adhesive surface non-viscous at normal temperature, *heating the pads in the caps*, severing the linings from the web of lining material and assembling the linings as they are severed from the web in the caps with the adhesive surface in contact with the heated pads to render the adhesive viscous and effect adhesion of the linings to the pads, then placing the linings in the caps under heat and pressure to effect an intimate adhesion between the linings and pads, and then placing the linings assembled in the caps under pressure during the cooling thereof.

Emphasis ours throughout unless otherwise stated.

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The History of the Applications for Warth's Parent and Divisional Patents.

The parent patent (Re. No. 19,117) is a reissue of Warth patent No. 1,788,260, dated January 6, 1931, and filed January 7, 1927 (R. p. 1061). The propriety of this reissue is not questioned.

Admittedly the original application disclosed the preheating of the cork claimed in the divisional patent and the preheating disclosure was constantly before the Patent Office in the form of a pending application from the date of filing of the parent application until the issuance of the divisional patent here in suit.

On November 7, 1930, and while the original application was pending, Warth filed a second application (R. p. 1668) with a specification identical with that of the original application. *This second application described, but did not claim, the preheating invention of the divisional patent.* It was filed as a result of a Patent Office requirement (R. p. 1250) that another feature⁶ of the original application disclosure be covered in a separate patent.

As has been said, Warth's parent application, as filed, had no drawing. While the application was pending, the Patent Office required Warth to file a drawing to illustrate devices by which his method could be carried out. He did this, electing to show, as a means for supplying the heat to the spot, a simple heated punch, thus describing *another* way of applying the heat to the spot in addition to his original description of preheating the cork.

At the time he filed this illustrative drawing Warth cancelled from his parent application, *but not from the second application which had already been filed*, the reference to preheating the cork and substituted the following broad statement as to the heating step of his method and as to the purpose of the newly-filed drawing (R. p. 1272, l. 11 *et seq.*):

⁶ The thermoplastically-coated strip material used in the method.

"The preferred method of applying the material to the cap is to utilize, at the time of assembly, both heat and pressure to unite the spot to the cork or cushion material * * *."

"In Figures 3 and 4, there is shown a suitable mechanism for applying the disc and adhesively uniting it to the cork insert at the time the strip is punched * * *."

The cancellation from the original specification of reference to preheating the cork, after having inserted it in a copending divisional application, was in accord with a customary practice, as the District Court said (R. p. 1800):

"The subject matter was not abandoned, as suggested by defendant, but was specifically reserved by continuous inclusion in the divisional application, and later in the second division. This has been approved and is the usual practice. *Writer v. Kiwad*, 63 Fed. (2d) 259".

After the parent patent (1,788,260) issued on January 6, 1931, and while the second application was pending, a patent issued to one Johnson (No. 1,852,578, R. p. 575) with claims covering specifically the "preheating" step which Warth had described in his original application and which was described in his then still-pending second application.

The Patent Office should have placed Johnson's application (R. p. 676), *filed more than two years after Warth's original application*, in interference⁷ with the Warth's original application by suggesting to Warth, Johnson's allowed claim 35⁸ (R. p. 713, quoted in Appendix, p. 45). That

⁷ U. S. C. Title 35, Sec. 52, (R. S. Sec. 4904) and Rule 96 of the Rules of Practice. (See Appendix, p. 43.)

⁸ Suggestion of an allowed conflicting claim of a later applicant to an earlier applicant is the procedure under Rule 96 (Appendix, p. 43) for declaring an interference. Claim 35 of the Johnson application had been allowed on September 10, 1930 (R., p. 717) several months before the Warth original application was allowed. The conflict between the parent Warth and Johnson applications is evident not only from the subsequent rejection of the Johnson

this claim read upon the Warth application disclosure is evident from (1) the subsequent rejection of Johnson's claim on the Warth parent patent after the latter issued (R. p. 725), and (2) the cancellation of the claim by Johnson (R. p. 726) in response to the rejection.

But only because the Patent Office overlooked the conflict between the two applications, no interference was declared. Consequently Warth had no knowledge, while his original application was pending, of Johnson's conflicting preheating claims which also stood allowed in the Johnson application. If an interference had been declared, then the issue of inventorship priority would have been determined while Warth's original application was still pending. Due to this oversight on the part of the Patent Office, Warth obtained no notice of the necessity for claiming preheating specifically until the Johnson patent later came to his attention. As soon as the Johnson patent came to Warth's attention, he copied⁹ the Johnson preheating claims by filing on April 4, 1933, a division of his then-pending second application and obtained an interference in which the Patent Office held Warth to be the prior inventor.

Warth had broadly claimed the invention (R. p. 1835) in his parent patent application and had had continuously on file in the Patent Office, first in his original application and then

claim (35) on the Warth patent, but also from a comparison of the Johnson claim (Appendix, p. 45) with the Warth patent claims, one of which is quoted p. 4 *ante*. This comparison shows that the two applicants were claiming substantially the same invention, the condition prescribed by the Statute and Rule (R. S. Sec. 4904 and Rule 96) for declaring an interference. The Johnson application had been pending in Division 14 (R., p. 714) and the Warth application (R., p. 1253) in Division 56, where it was endorsed for allowance (R., p. 1275), although it was transferred to Division 14 for the formal allowance (R., p. 1288).

⁹ The Johnson patent claims were copied within a year after the Johnson patent had issued, and, therefore, within the two years allowed by *Chapman v. Wintroath*, 252 U. S. 126.

in his second application, a complete disclosure of the subject-matter covered by the interference claims. Because of this *continuity of disclosure by Warth*, the Patent Office gave the divisional application the benefit of the filing date of the second (1930) application, which disclosed but did not claim preheating, and through the latter the benefit of the filing date of the original application of which the second was admittedly a division. Accordingly the claims of the Johnson patent were awarded to Warth as the prior inventor and are now the claims of the Warth divisional patent here in suit.

This was all in accordance with the Patent Office practice as it has existed for over fifty years. The practice was recognized and approved by this Court as far back as *Smith et al. v. Sprague*, 123 U. S. 249, 250, and its propriety was reiterated by the Commissioner of Patents in *Hopfelt v. Read*, 1903 Commissioner's Decisions, 319, 321. See the quotation from the latter decision in the Appendix, p. 48.

The Decisions of the Lower Courts.

The District Court for the Eastern District of New York (Campbell, J.), found both patents valid and infringed. The Circuit Court of Appeals for the Second Circuit (Manton, J., dissenting) reversed the decree, holding that the parent patent was not infringed and that the divisional patent was invalid because of laches in filing the application.

Grounds Upon Which the Circuit Court of Appeals Decision is Based.

(1). Reversing the finding of the District Court (R. p. 1805) as to the divisional patent, the Circuit Court of Appeals held that the mere lapse of two years and four months between the grant of the parent Warth patent and the presenting of specific claims to preheating in Warth's divisional application, invalidated such claims in the absence of a legal excuse, *notwithstanding the fact that during this*

*interval no intervening bar had arisen.*¹⁰ The subject-matter of the specific preheating claims had not been disclosed in any patent or publication, and had not been in public use by others for two years or more before the claims were presented and, therefore, there arose no bar to the divisional patent analogous to the bars created by the statute (R. S. Sec. 4886, Appendix, p. 44). The Court of Appeals said (R. p. 1837):

"The disclosure, however, had been continuously on file since January 7, 1927; [the filing date of the parent patent] and so the plaintiff contends that it is entitled to that filing date. We do not so understand the law, as laid down in *Webster Co. v. Splitdorf Co.*, 264 U. S. 463, 471, 44 S. Ct. 342, 344, 68 L. Ed. 792. Prima facie the two-year time limit applies to divisional applications, and an applicant who waits longer before claiming the invention disclosed in his application must justify his delay by proof of some excuse. No such excuse appears here."

(2). The Court of Appeals refused to excuse Warth's delay in presenting preheating claims (a) because it held that the parent patent claims are not broad enough to cover preheating and (b) because it declined to accept as an adequate excuse the fact that the claims of the parent patent *were intended and believed to be*, and *apparently* are, broad enough to comprehend in their scope the specific preheating.

¹⁰ The Court of Appeals referred to the issuance of the Warth parent patent more than two years before the divisional patent claims were asserted, but the parent patent contained no description of the method of the Warth divisional patent and hence was not a printed publication. The Court of Appeals also referred to the Johnson patent, but this issued less than a year before the claims were asserted by Warth and hence is not a bar under the rule of this Court in the *Chapman* case, *supra*. Respondent's use of the invention was also urged as being more than two years prior to the Warth divisional application, but was found by the District Court not to anticipate (antedate) the filing date of the Warth divisional patent (R., p. 1803) and this finding was not disturbed by the Court of Appeals, although respondent strenuously urged that such finding was error.

method. The Court of Appeals also disregarded the fact that Warth had maintained the disclosure of preheating continuously on file in a pending and regularly prosecuted application and had asserted his inventorship as soon as the Johnson patent came to his attention, and the further fact that Warth failed to receive actual notice of Johnson's claim to inventorship while the parent Warth application was pending because the Patent Office failed, through oversight, to declare an interference between the Warth and Johnson applications, as required by the Statute and the Patent Office Rule.

(3). In refusing to hold the Warth parent patent claims sufficiently broad to cover preheating and therefore to constitute an excuse for Warth's delay, the Court of Appeals read into and restricted the claims of the parent patent to the use of a "heated plunger" as a means for applying heat to the spot upon or at the instant of assembly. In this, the Court of Appeals did what this Court said in *Altoona v. American Tri-Ergon*,¹¹ 294 U. S. 477, 487, should not be done; that is, included in a claim "parts of the specifications, or of other claims, which the patentees failed to include in it", and it also disagreed with the District Court which had said (R. p. 1790-91):

"The claims in suit are not limited to the application of heat directly to the punch, and they are not so limited by the drawing offered by Warth in the prosecution of his patent, simply for the purpose of illustrating a suitable means for effecting the simultaneous application of heat and pressure at the instant of depositing the spot.

"The prior art did not, nor do I find anything in the records of the Patent Office actions which limit the claims in suit to producing in any particular way the heat which is utilized at the instant of assembly."

¹¹ Also in *Smith v. Snow*, 294 U. S. 1, 11; *Smith v. Hall*, 301 U. S. 216, 220.

SPECIFICATION OF ERRORS.

1. The Circuit Court of Appeals for the Second Circuit erred in holding that a two year time limit for presenting claims in a divisional application, as announced by this Court in *Webster Co. v. Splitdorf Co.*, 264 U. S. 463, is applicable in the present case and *in the absence of adverse public use, patenting or publication more than two years before the presentation of the claims.*

2. The Circuit Court of Appeals for the Second Circuit erred in ignoring the *apparent* and *intended* breadth of the claims in the parent patent and in not holding that, since these claims were **believed** and **intended** to be, and **apparently are**, of a breadth to cover the subject-matter of the divisional patent, the delay in presenting the claims in the divisional patent is excused.

3. The Circuit Court of Appeals erred in failing to find the parent patent claims sufficiently broad to cover pre-heating and to excuse the delay (because it read into the claims of the parent reissue patent a part of the specification which the patentee did not include in the claims) and in refusing to accept the claims as written, namely, to cover the application of heat at the instant of assembly whether it be applied (a) by a heated punch, as illustrated in the patent, or (b) by a heated cork cushion, as initially described in the application, or (c) partly by a heated punch and partly by a heated cork, as the method is practiced by both petitioner and respondent.

4. The Circuit Court of Appeals erred (a) in reversing the District Court which had adjudicated the patents in suit as valid and infringed; and (b) in issuing its mandate directing the said District Court to enter a decree dismissing petitioner's bill of complaint.

ARGUMENT.**Chapter I—The Question of Laches.****POINT I.**

The Court of Appeals Should Have Accorded the Warth Divisional Patent the Benefit of the Filing Date of the Second (1930) Application and Also of the Filing Date of the Original Warth Application Under the Rule Established by this Court in *Chapman v. Wintroath*, 252 U. S. 126.

The refusal of the Circuit Court of Appeals to accord to the Warth divisional patent the priority rights of the original or even of the second (1930) application directly conflicts with the decision of this Court in *Chapman v. Wintroath*, 252 U. S. 126, and *Overland v. Packard*, 274 U. S. 417.

In *Chapman v. Wintroath*, *supra*, this Court reiterated the rule that a divisional application is entitled to the benefit of the filing date of the parent application "with all its priority of right" for anything disclosed in the parent application, whether claimed in the parent application or not. This Court said:

"To this we must add that not only have later or divisional applications not been dealt with in a hostile spirit by the courts, but, on the contrary, designed as they are to secure the patent to the first discoverer, they have been favored to the extent that where an invention clearly disclosed in an application, as in this case, is *not claimed therein but is subsequently claimed in another application, the original will be deemed a constructive reduction of the invention to practice and the later one will be given the filing date of the earlier, with all of its priority of right.* (Citing) *Smith & Griggs Manufacturing Co. v. Sprague*, 123 U. S. 249, 250; *Von Recklinghausen v. Dempster*, 34 App. D. C. 474, 476, 477."

Following the decision in *Webster v. Splitdorf*, 264 U. S. 463, this Court said in the *Overland* case, *supra*, that the priority rights of a divisional application should not be diminished by equitable considerations. Interpreting the earlier *Chapman v. Wintroath* decision, this Court said (at p. 426):

"This court held [in *Chapman v. Wintroath*] that under Sec. 4886 of the Revised Statutes, as amended March 3, 1897, two years was granted in such a case before the right to file a divisional application had been lost. *The Court based its decision that the statutory period could not be reduced by equitable considerations or those of public policy on the language which we have just quoted from Mr. Justice Brewer in his opinion in the Telephone case.*"

Our understanding of the rule thus established is that an applicant has two years from the date of any intervening adverse right, analogous to the bars established by the Statute,¹² in which to present claims to subject-matter disclosed in any parent or prior application, whether claimed therein or not.

In the case at bar, there was no adverse public use or printed publication of the preheating invention of Warth's divisional patent more than two years prior to the date he presented the claims of that patent. In the *Chapman* case, the Court stated that, where a patent has issued to another more than two years before its claims are copied by a divisional applicant, the lapse of such period *prima facie* bars the divisional applicant. Such an earlier patent to another is an intervening adverse right and is analogous to the two year bar established by the statute.

But, in the case at bar, the Johnson patent issued less than a year before its claims were copied by Warth in his divisional application. Consequently, the Court of Appeals for the Second Circuit overlooked the admonition of

¹² U. S. C. Title 35, Sec. 31 (R. S. Sec. 4886). See Appendix, p. 44.

this Court in the *Chapman* case (p. 135) with reference to a patent such as Johnson's that:

"Such a prior patent is in no sense a bar to the granting of a second patent for the same invention to an earlier inventor, provided that his application is filed not more than two years after the date of the conflicting patent. The applicant may not be able to prove that he was the first inventor but the statute gives him two years in which to claim that he was and in which to secure the institution of an interference proceeding in which the issue of priority between himself and the patentee may be determined in a prescribed manner."

Warth acted in compliance with the above rule, copied the Johnson claims within one year from the date his patent issued, and was awarded the claims as prior inventor.

Moreover, Warth's parent patent, as issued, contained no description of the preheating step, and was not a printed publication. Such a patent has been held not to be a bar even when it contains a description of the divisional patent invention.¹³

POINT II.

In the Absence of Intervening Rights More Than Two Years Before Claims Are Presented in a Divisional Application, No Excuse for Delay is Required by the Decision of this Court in *Webster v. Splitdorf*, 264 U. S. 463.

In the case at bar, the Court of Appeals extended the ruling of this Court in *Webster v. Splitdorf* beyond anything justified by that or any other decision of this Court, since it formulated a bar to divisional patents which has no basis, as such or by analogy, in the fundamental statute (R. S. Sec. 4886—Appendix, p. 44).

In the *Webster* case, this Court simply applied the doctrine of *Chapman v. Wintroath* to a case in which interven-

¹³ *Folberth Co. v. Mayo Co.*, 292 Fed. 883, 894 (D. C. N. D. Ill.).

ing adverse rights analogous to those established by the Statute (R. S. Sec. 4886) had arisen more than two years before the claims were presented.

The facts of the *Webster* case briefly were: The original application for the Kane patent in suit was filed February 2, 1910. In 1915, Kane filed a divisional application, in the prosecution of which, on June 17, 1918, claims were presented to subject-matter *deliberately* not claimed, either broadly or specifically, in the original application, because Kane considered their subject-matter one merely of design.

These claims were presented five years after a complete disclosure of their subject-matter appeared in an issued Podlesaks patent and an equal length of time after the device had been in general public use by others.

This Court found "that Kane did not originally intend to assert" the claims, that the claims were "*broad*er than those originally sought" and "that the delay was unreasonable, and, under the circumstances shown by the record, constitutes laches" by which Kane lost his right to a patent on the subject-matter of the late-presented claims.

We do not understand that this Court held in *Webster v. Splitdorf*, as stated by the Court of Appeals in the case at bar, that, in *any* case where there has been a delay of more than two years in presenting claims in a divisional application, such delay, *even in the absence of adverse public use or intervening rights*, invalidates the patent unless excuse be shown.

Other Courts of Appeal have held that the doctrine of *Webster v. Splitdorf* applies only in the presence of intervening adverse rights. See the quotations in the Appendix, (pp. 45-48) from *Utah Radio Products Co. v. Boudette* (C. C. A. 1st), 78 F. (2d), 793, 799, *Wagenhorst v. Hydraulic Steel* (C. C. A. 6th), 27 F. (2d), 27, 29, 30, *Wirebounds Patents Co., et al. v. Saranac* (C. C. A. 6th), 37 F. (2d) 830, 840, 841, and *Wirebounds Co. v. Saranac* (C. C. A. 6th), 65 F. (2d) 904, 905, 906.

The facts in the case at bar are not analogous to those in the *Webster* case. While here there was a delay of more than two years in presenting the claims specific to preheating, *yet here there had been no adverse public use of the invention before or during the two year period.*¹⁴

Nor had there been any disclosure of the invention in an issued patent or printed publication, except the Johnson patent No. 1,852,578 (R. p. 575), which issued *only a year* before the claims were asserted, and, therefore, well within the two year period allowed for copying the Johnson claims under the *Chapman* case, *supra*.

Moreover, since the Court of Appeals found (R. p. 1835) that Warth had broadly claimed the subject-matter of the divisional patent during the pendency of his parent patent, there was no *deliberate* failure, as in the *Webster* case, to claim the subject-matter prior to claiming, it specifically in the divisional application.

Further, Warth *believed* (p. 33, *infra*) he had covered the invention of the divisional patent by the claims issued in the parent patent. Certainly the claims of the parent patent are at least *apparently* of such breadth (pp. 26-36, *infra*) and it is petitioner's position that they are, *in fact*, of such breadth. The District Court so held (R., pp. 1791-92), but the Court of Appeals erroneously gave the claims a narrow construction, as discussed *infra*, p. 27, *et seq.*

In short, the Court of Appeals held that Warth's unintentional delay of two years and four months in claiming the preheating method specifically, *absent intervening*

¹⁴ Respondent did attempt to prove use of preheating by itself and others more than two years prior to the divisional patent application, but the District Court held (R., p. 1803):

" * * * the defendant has not proved any use of the preheating method, to anticipate the filing date of the first divisional application, November 7, 1930, or the filing date of the second divisional application, April 4, 1933".

This finding was not disturbed by the Court of Appeals, and, therefore, should be accepted by this Court under the rule of *Adamson v. Gilliland*, 242 U. S. 350, 353.

rights, is the equivalent of the eight year *deliberate delay and failure* to claim an invention, considered in the *Webster* case, where *public rights in the meantime had accrued*. On this finding, the Court of Appeals has denied Warth the benefit of the general rule that a divisional patent relates back to the filing date of its parent patent.

The error as well as the extreme harshness of the rule announced by the Court of Appeals is evident from the fact that it applies to divisional applications a two year time limit which is not imposed upon them by the fundamental statute.¹⁵ The statute bars the allowance of a patent *only if there has been a printed publication, public use or sale of the invention more than two years before the filing date of the application*. The rule established by the Court of Appeals for the Second Circuit requires an excuse for delay and *prima facie* bars a patent, whether statutory bars, as such or by analogy, exist or not. The rule, as applied in the case at bar therefore, is in conflict with the statement of this Court in *United States v. American Bell Telephone Co.*, 167 U. S. 224, 247, that "No Court can disregard any statutory provisions in respect to these matters on the ground that, in its judgment, they are unwise or prejudicial to the interests of the public."

In the case at bar, aside from the admitted use of the invention by petitioner,¹⁶ the District Court and the Court of Appeals found no use of the invention or public disclosure thereof more than two years before the filing of the divisional application.

Consequently, if the rule of the Court of Appeals is correct, a divisional application is not entitled even to the benefit of its own filing date if there has been a two-year delay in claiming its subject-matter. This is true since the District Court found (footnote p. 18; *ante*) that respondent had not proved prior use of the divisional patent invention and there was no contrary finding by the Court of Appeals.

¹⁵ U. S. C., Title 35, Sec. 31, (R. S. Sec. 4886), Appendix, p. 44.

¹⁶ See discussion, p. 22, *infra*.

To hold a divisional patent invalid in the absence of proof of prior use, as the Court of Appeals did in the case at bar, certainly diminishes the patentee's rights under the statute,¹⁷ and is plainly inconsistent with the decision of this Court in *Overland v. Packard* (p. 15, *ante*).

The Court of Appeals found no statutory bars and refers only to the issuance of the parent Warth patent and to the issuance of the Johnson patent during the two year period. But the parent Warth patent, as issued, *contained no description of the preheating invention*, and hence was not a printed publication of the invention or an *adverse* patent or right. The Johnson patent issued *less than one year* before Warth presented the preheating claims, and hence is not a bar, under the decision of this Court in *Chapman v. Wintroath* (p. 14 *ante*).

In the *Webster* case, this Court drew an analogy between the two year period allowed (*Chapman v. Wintroath*) for presenting claims in a divisional application, and a two year limitation for filing application for a broadened re-issue patent. In each case, however, there is a definite occurrence analogous to the bars created by the Statute (R. S. Sec. 4886), from which the two year limit begins to run.¹⁸ **We submit that the two year period announced in the Webster case should begin to run only when there has been some adverse intervening right analogous to the statutory bars, and that on this theory the doctrine of laches announced in the Webster case is based.**

The reasonableness of requiring a showing of intervening rights from which to date the two year period of laches announced in the *Webster* case is apparent from the fundamental theory of laches explained by this Court in

¹⁷ R. S. Sec. 4886, Appendix, p. 44.

¹⁸ The issued patent from which the claims are copied is a printed publication; in applying for reissue the original patent is a printed publication. Therefore, each is one of the bars specified in R. S. Sec. 4886.

Gallihier v. Cadwell,¹⁹ 145 U. S. 368, 372, 373, with reference to cases decided on laches:

"They proceed on the assumption that the party to whom laches is imputed has knowledge of his rights, and an ample opportunity to establish them in the proper forum; that by reason of his delay the adverse party has good reason to believe that the alleged rights are worthless, or have been abandoned; and that because of the change in condition or relations during this period of delay, it would be an injustice to the latter to permit him to now assert them.

. . . .

"They all proceed upon the theory that laches is not like limitation, a mere matter of time; but principally a question of the inequity of permitting the claim to be enforced—an inequity founded upon some change in the condition or relations of the property or the parties."

A reading of this Court's decision in the *Webster* case shows that the Court based its application of the doctrine of laches on the theory that one should not be permitted to expand his claim, "to the detriment of those who have, in consequence, been led to act as though it were abandoned". (*Webster v. Splittorf*, p. 467). Obviously, if there are no intervening rights, there can be no question of inequity or change in the condition or relations of any parties, especially where, as here, the inventor from his original filing date has asserted claims which he believed, and which apparently do, cover the divisional patent invention. See pp. 26-36 *post*.

¹⁹And in other decisions therein cited.

POINT III.

Petitioner's Own Use of the Warth Divisional Patent Invention Does Not Invalidate the Patent.

Respondent did not contend before the lower Courts, nor did either Court find, that petitioner's admitted use of the preheating invention for some years prior to the filing of the Warth divisional application invalidates the patent. However, we will refer briefly to this point since it is raised before this Court in the case of *General Talking Pictures v. Western Electric* (No. 357).

Courts which have considered the question have held that a divisional patent is not barred by use by the patentee or his licensees. See *Wirebounds Patents Co. v. Saranac*, 37 F. (2d) 830, 841 (C. C. A. 6); *American Chain Co. v. Franklin New York Co.*, 34 F. (2d) 551 (E. D. N. Y.); *American Laundry Mch. Co. v. Prosperity Co.*, 295 Fed. 819 (C. C. A. 2).

A contrary interpretation of the law would largely nullify the spirit and intent of the fundamental patent statute (R. S. Sec. 4886—Appendix, p. 44). Under the statute an inventor may publicly use his invention for two years before filing patent application. The courts have frequently commended inventors for taking advantage of this statute by subjecting the invention to thorough test, even in commercial use, as is often necessary, instead of rushing into the Patent Office with disclosures of untried and unperfected developments, and the importance of this statutory provision to the general public, as well as to inventors, has been emphasized.²⁰

If it were the law that an inventor's own use, or use authorized by him, more than two years before the filing of a divisional application bars the issuance of a patent, no inventor could safely make his invention available to the public either before or even after he had filed an application, until it became certain that it would not be neces-

²⁰ *Elizabeth v. Pavement Company*, 97 U. S. 126, 137; *Kendall v. Winsor*, 62 U. S. 322, 328-329; *Agawam Company v. Jordan*, 74 U. S. 583, 607-608; *Joy v. Morgan*, 295 Fed. 931, 935, 936.

sary or desirable for him to file any divisional application to protect part of his original application disclosure.

Frequently, the requirement or the desirability for filing divisional applications does not arise until years after the original application for patent has been filed. Such was the situation which confronted the inventor in *Chapman v. Wintroath*, *supra*, where it was six years after the Chapman application was filed before it became apparent to Chapman or his attorneys that a certain phase of his initial disclosure should be claimed. That phase Chapman had to claim in a divisional application. The statute²¹ encourages and requires a complete disclosure and the completeness of the initial application disclosure is ordinarily the reason for the filing of subsequent divisional applications, since the Patent Office will not permit the claiming in a single patent of inventions which are separately classified.²²

To hold that a patent is barred by the inventor's own public use more than two years before the filing of a divisional application would compel him to anticipate all possible requirements or reasons for divisional applications. The necessity for many divisional applications arises from events which cannot be foreseen, such as the inadvertent issuance of patents to another, as in the *Chapman* case and in the case at bar, or changing of the Patent Office classification of patents which is constantly being revised. Consequently, if it were the rule that use by the inventor more than two years before filing a divisional application is a statutory bar, the inventor and the public would be deprived of the benefits of the fundamental statute (R. S. Sec. 4886) which permits and encourages public use and test of inventions for two years prior to the filing of application for patent.

²¹ U. S. C. Title 35, Sec. 33, (R. S. Sec. 4888) Appendix, p. 44.

²² For example, in 1934 and 1935, the last years records which were maintained by the Patent Office, approximately every eighth applicant for patent was required to file divisional applications to protect his full disclosure. In 1934, examination of applications resulted in 7162 requirements for divisions and in 1935, 7609 requirements.

CHAPTER II—THE QUESTION OF EXCUSE FOR DELAY.

POINT IV.

If Warth's Delay in Specifically Claiming Preheating Requires an Excuse, it is Found in the Fact that the Parent Patent Claims (a) Do, in fact, Cover and (b) Were Reasonably Believed to Cover the Subject Matter of the Divisional Patent Claims.

This Court said in the *Webster* case that more than two years' delay in presenting claims after an intervening right had arisen may be excused "by special circumstances, which show it to have been not unreasonable". In the case at bar, the Court of Appeals said (R., p. 1837):

"* * * an applicant who waits longer [than two years] before claiming the invention disclosed in his application must justify his delay by proof of some excuse. No such excuse appears here".

Lower Courts have heretofore recognized, as an excuse for delay, the fact that the claims in the parent patent do, in fact, cover the later-claimed divisional subject matter.

In the case at bar, the Court of Appeals recognized this law and correctly stated the ruling and the reason for it as follows (R. p. 1837):

"Had Warth chosen to retain in his parent application broad generic claims which might cover the preheating method, then indeed the Splitdorf rule might not be applicable. *Carson v. American Smelting & Refining Co.*, 4 F. (2d) 463, 470 (C. C. A. 9). The delay would be excused since a patentee is not to be held at fault for failing to have divided his claims at an earlier date, merely because he might have, when instead he had elected to prosecute the broader claims of his original application. *Hartford-Empire Co. v. Nivison-Weiskopf Co.*, 58 F. (2d) 701, (C. C. A. 6)."

It has also been held that a *seeming* broad scope of parent patent claims and the inventor's belief that they were of a scope broad enough to cover the later-claimed divisional subject matter, *even though he was mistaken*, is an excuse for delay in presenting specific claims. In *Wagenhorst v. Hydraulic Steel* (C. C. A. 6) 27 F. (2d) 27, 31, 32, the Court said:

"It may be said, with some certainty as to original claim 2, and with some probability as to claims 1 and 3, that, if granted, they would have seemed to cover defendant's later structure, and might or might not have been construed in that way. The trouble was that with that construction they went beyond the applicant's device and reached the prior art. Wagenhorst's amended divisional claim restricted his claimed invention to the specific form of its concrete embodiment. This is a very different thing from the enlargement in the Webster Case".

See also *McGrath v. Burke*, 12 F. (2d) 161, 162 (App. D. C.) and *MacLaren v. Stoetzel*, 38 F. (2d) 125, 128, 129 (C. C. P. A.), in each of which delay in presenting specific claims was excused because the inventor *believed* he had covered the subject matter by the claims of an earlier patent or application, notwithstanding the fact that such belief was mistaken.

In the case at bar, the Court of Appeals found no excuse for Warth's delay. It refused to give him the benefit of the ruling of such decisions as the *Hartford-Empire* case (*supra*, p. 24) because of its erroneous conclusion that Warth's parent claims do not cover preheating. This conclusion was based on a plain error, as we show, *infra*, pp. 26-32.

The Court of Appeals also failed to give Warth the benefit of such rulings as that in the *Wagenhorst* and other cases cited (*supra*), because it ignored the fact that the parent patent claims, at the very least, are susceptible of an interpretation broad enough to cover preheating.

Hence, Warth's belief that they were of such broad scope and his reliance thereon were reasonable, and this brought him directly within the rule of the cited cases, as we show *infra*, pp. 33-36.

A. It is sufficient excuse that the parent patent claims do cover generically the preheating method of the divisional patent.

The District Court found that the parent patent claims should be interpreted to cover *any* way of utilizing heat simultaneously with pressure at the instant of assembly, whether by heated punch or preheated cork. The Court said (R. pp. 1790-91):

"The claims in suit are not limited to the application of heat directly to the punch, and they are not so limited by the drawing offered by Warth in the prosecution of his patent, simply for the purpose of illustrating a suitable means for effecting the simultaneous application of heat and pressure at the instant of depositing the spot.

"The prior art did not, nor do I find anything in the records of the Patent Office actions which limit the claims in suit to producing in any particular way the heat which is utilized at the instant of assembly."

The Court of Appeals did not disagree with the finding of the District Court that the claims, when broadly so construed, avoid the prior art; that is, are not anticipated, when so construed, either by petitioner's old slide machine or by any prior patent. The Court of Appeals simply refused to accord the claims the broad construction adopted by the District Court, solely because (a) it misinterpreted the language of the patent claims, and (b) it drew certain inferences from the cancellation of a reference to preheating just before the grant of the parent application and the withdrawal of claims broad enough to cover preheating but (a thing the Court overlooked) also broad enough to be rejected by the Patent Office as including the prior art.

1. THE LANGUAGE OF THE PARENT PATENT CLAIMS CLEARLY
COVERS APPLYING HEAT TO THE SPOT BY EITHER A
HEATED PUNCH OR A HEATED CORK CUSHION.

Referring to that clause of the Warth claim which reads
“and upon assembly applying simultaneously *to the*
spot pressure and sufficient heat”

the Court of Appeals said (R. p. 1836) that this

“clearly means *applying* the heat at the time of pressure, not pressure by a cold punch on an already heated crown” (Court’s emphasis).

But, in saying this, the Court clearly overlooked the all-important words **“to the spot”**.

Warth’s method, as stated in the claim, is concerned *only* with the time when the heat is applied **to the spot**, not when it may be applied to some other part of the crown. No matter at what point in its travel the non-spotted crown receives its heat, obviously **none of that heat can be applied “to the spot” until the spot is pressed against the heated crown.**

As a consequence of its overlooking the phrase “to the spot”, the Court went on to say erroneously that the above-quoted clause of the claim *cannot* mean “pressure by a cold punch on an already heated crown”, i. e., on a pre-heated non-spotted crown. Clearly, that operation is precisely one which the clause does cover, since in such an operation, the heat and pressure are applied simultaneously “to the **spot**” only upon or at the instant of its assembly with the crown, exactly as the claim specifies.

Because of this erroneous and strained construction, the Court said (R. p. 1835) that the claims must be limited to mean “that the heat and pressure are applied by the cutting punch”. By thus disregarding the words “to the spot”, and reading into the method claims a mechanical limitation, the Court has rewritten the claims as the Patent Office would not have permitted Warth himself to do, *since*

the heated punch was not part of his original disclosure and was added to the application disclosure during the prosecution of the application merely as an example of a way "to utilize at the time of assembly, both heat and pressure". In re Dilg, 25 App. D. C. 9, 11.

Even if the application had originally disclosed only the heated punch, nevertheless the claims would have covered preheating the cork, since, as the uncontradicted testimony shows, (R. p. 69), preheating is only another way, though a novel and important one, of

"doing the same thing that Warth teaches in the reissue [parent] patent, that is utilizing the heat * * instantly at the time of assembly. It accomplished the same final result * * *".

Thus, a hot punch and a preheated cork function for the same purpose, namely, to transmit or apply heat to the spot at the instant of assembly, the difference being that, by the heated cork, the heat is applied from below and, by the heated punch, from above the spot. *Defendant actually uses both, because its heat is applied partly by the punch and partly by the cork* (R. p. 95, RDQ 282).

Moreover, the description of the heated punch (R. p. 550, l. 56 *et seq.*) is immediately preceded by the broad statement (R. p. 550, l. 46 *et seq.*):

"The preferred method of applying the material to the cap is to utilize, at the time of assembly, both heat and pressure to unite the spot to the cork cushion material insert or facing of the cap."

"In Figures 3 and 4, there is shown a suitable mechanism for applying the disc and adhesively uniting it to the cork insert at the time the strip is punched from the disc and assembled with the cap".

The Court of Appeals has inferred from this amendment to the specification that the claims presented at the same time were not intended to cover preheating. We submit that the inescapable inference in view of the broad lan-

guage inserted in the specification is that the patentee intended to emphasize the broad scope of his claim. Warth said, in effect:

"I comprehend in my claim *any* way of producing heat for use at the time of assembly, whether by heating the punch or by heating the cork".

The heated punch is thus described merely as "a suitable mechanism" for adhering the spot at the time of assembly in accordance with the method thus broadly stated.

Hence, it is clear that the specification (1) states the method as broadly involving the application of heat and pressure to the spot at the time of assembly without limitation to the particular way they are applied, and (2) describes the heated punch merely as illustrative of "a suitable mechanism" for practicing this broad method.

2. THE FILE OF THE PARENT PATENT SHOWS THAT NO AMENDMENTS WERE MADE WHICH JUSTIFY READING INTO THE CLAIMS THE "HEATED PUNCH" LIMITATION.

The Court of Appeals referred (R. p. 1835) to certain amendments made during the prosecution of the Warth parent patent, and particularly the insertion of the drawing of the heated punch as well as the description of the punch operation.

We have already shown (*ante*, pp. 7, 8) that Warth's patent drawing, including the heated punch, is merely illustrative of what he identified as "a suitable mechanism" by which his method could be carried out. We have also shown (*ante*, p. 28) that the uncontradicted proof is that a preheated cork and a heated punch each accomplish the same final result. As the District Court (R. p. 1790) said:

"The sole purpose of preheating the cork immediately in advance of the punch is to create heat, which will be available at the instant the spot is deposited, so that there will be provided the combined effect of heat and pressure."

Consequently, it was wholly immaterial whether Warth showed, as part of his illustrative mechanism, a heated punch or preheated cork. Both of them were known to him and described in his application as suitable procedures for applying heat to the spot at the instant of assembly. A showing of either will support a claim drawn in language sufficiently broad to cover both. The fact that he selected only one of them for purposes of illustration creates no inference that, thereby, he intended to limit his invention to that particular procedure.

It is true that, as the Court of Appeals said (R. p. 1835), when Warth filed his drawing, he also cancelled reference to preheating. But we have shown (*a*) (p. 7, *ante*) that, at the same time, he inserted the broader statement (R. p. 1272, quoted p. 8 *ante*) that his preferred method is broadly to utilize heat at the instant the spot is deposited, and (*b*) that such cancellation is customary procedure when, as here, a divisional case is filed (*ante*, p. 8).

Certainly, if any inference from this amendment to the specification is warranted, it is that Warth intended to emphasize, rather than to restrict, the breadth of his invention and to cover *any* way of applying heat to the spot at the instant of assembly.

As a further reason for its limitation of the parent patent claims to a heated punch, the Court of Appeals referred to the cancellation of certain broader claims (R. p. 1835) when the parent patent claims were inserted by amendment. But the Court of Appeals overlooked the fact that these cancelled claims were so broad as to be rejected by the Patent Office on prior art (R. pp. 1253, 1256). Furthermore, none of such cancelled claims had the scope petitioner is urging for the parent patent claims and the scope which the District Court gave them. Hence, such cancellation cannot be used to limit the present claims to a heated punch, because certainly no reference is made in them to a heated punch. This is not a case where a patentee inserted a limitation (heated punch) in his claims in order to induce their allowance by the Patent Office.

Finally, the law does not warrant the inclusion in the Warth claims of an element (heated punch) not expressly included therein. Yet that is precisely what the Court of Appeals did when it said that the Warth claims must be limited to mean "that the heat and pressure are applied by a cutting punch" (R. p. 1835).

This Court has held in a number of recent cases²³ that parts of the specification or of other claims which the patentee has not included in his claim cannot be read into that claim by Court interpretation, even to save the claim. Yet, in the case at bar, the Court of Appeals rewrote the Warth claims to include the heated punch, thus doing what this Court has said should not be done and, furthermore, as pointed out (*ante*, pp. 27, 28), doing what the Patent Office would not have permitted Warth himself to do since the heated punch was not part of the original disclosure. (*In re Dilg. ante*, p. 28.)

3. THE COURT OF APPEALS' CONSTRUCTION OF THE CLAIMS IS INCONSISTENT WITH THE EVIDENT INTENT OF THE PATENTEE AND DEPRIVES HIM OF PROTECTION FOR HIS ACTUAL INVENTION.

This Court has repeatedly held that, if a patent claim is susceptible of two constructions, that one should be adopted which will secure to the patentee his actual invention rather than one which is fatal to the grant.²⁴ By limiting the claims to a hot punch, the Court of Appeals has deprived petitioner of all protection for the Warth invention as it has always been employed by petitioner (R., pp. 94, 372-4).

The uncontradicted evidence is that petitioner has been using the preheating invention since 1926 (R. pp. 381, 383). Photographs of petitioner's 1926 machines (R. pp. 612A,

²³ *Altoona v. American Tri-Ergon*, 294 U. S. 477, 487; *Smith v. Snow*, 294 U. S. 1, 11; *Smith v. Hall*, 301 U. S. 216, 220.

²⁴ *Smith v. Snow*, 294 U. S. 1, 14; *Keystone v. Adams*, 151 U. S. 139, 144, 145.

612B), original 1926 drawings (Exhs. 47, 48, 49-Physical), and a typical spotting unit from such a machine (Exh. 46) are in evidence and were proved (R., pp. 374-379).

No one questions that preheating was part of Warth's original application disclosure, or that such disclosure was continuously before the Patent Office, either in the original or in the divisional applications, until the preheating claims were made.

But more than this, by undisputed evidence it has been shown that the patentee Johnson (R. p. 575), from whom respondent acquired knowledge of the invention through machines purchased from Johnson, visited petitioner's factory in 1928 and observed petitioner's practicing of the preheating methods (R. pp. 348-9; 358; 375). Johnson had been an inventor and builder of crown cap machinery for thirty-three years (R. p. 160) and had been working since 1927 to develop a method of applying spots to crowns (R. p. 167). Yet it was not until *after* he had visited petitioner's factory and studied the operation of petitioner's machines that he applied for the patent with which Warth was in interference and was able to supply respondent with machinery using the preheating method which is here charged to infringe.

Certainly it is clear that the original Warth application was filed to protect this method, as used, including preheating.

By restricting the claims of the parent patent to a heated punch, the Court of Appeals has so narrowed the patent that (1) it does not protect what Warth invented and disclosed and what petitioner has done since it began to use the Warth method and (2) it does not cover what respondent is doing as a result of information which its machinery supplier, Johnson, obtained by inspecting petitioner's operations.

Obviously, therefore, the interpretation of the parent patent adopted by the Court of Appeals is one which does not secure to the patentee his actual invention.

B. It is sufficient excuse that Warth reasonably believed that the parent patent claims cover the subject matter of the divisional patent claims and acted in accordance with that belief.

Since, in the case at bar, the Court of Appeals agreed that Warth's delay would be excusable if the Court had construed the parent patent claims to be of such scope that they would cover preheating, it is submitted that it should have, in any event, excused the delay because the parent patent claims are, at least *seemingly*, broad enough on their face to cover preheating and that Warth believed in and relied on such seeming scope.

This should be the rule since one's diligence at a particular time should be measured in the light of the circumstances (parent patent claims' scope) as then reasonably understood by him, and not as later and unexpectedly determined by judicial inquiry.

In each of the cases cited (*ante*, p. 25), delay in filing application and presenting claims was held excused because of the belief, even though mistaken, that the subject-matter had been covered by earlier applications or patents.

The foregoing discussion (*ante*, pp. 27-32) of the language of the parent patent claims and of the patent record shows that the claims of the parent patent, at least on their face, are reasonably susceptible of an interpretation which will cover preheating.

Moreover the record establishes that Warth actually believed the claims to be of such breadth and so relied upon them. His conduct is consistent with no other conclusion.

As soon as petitioner learned that Johnson had obtained his patent and was making for others machines for practicing the preheating method (R. pp. 522, 523) he was notified of infringement of the parent patent. Petitioner's notice of infringement to respondent (R. p. 2185) of infringement of the parent patent (R. p. 565), when (R. p. 521) petitioner learned of respondent's activities, is further evidence that

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petitioner, *in fact*, relied upon the claims of the parent patent as covering preheating.

The conclusion of the District Court that the parent patent covered preheating is evidence that petitioner's reliance on the broad scope of the claims of that patent was not unreasonable. This is also shown by Johnson's admission of concern with respect to infringement (R. pp. 164, 925) and his acceptance of a license under the patent.

Summary as to Excuse for Delay.

If, under the circumstances of this case, an excuse for Warth's delay in asserting specific preheating claims is required, then the facts, which we have just explained in detail, adequately provide such excuse.

Warth had the invention in use as early as 1926. His original specification admittedly disclosed it and his original claims admittedly covered it. He obtained, in the parent patent, claims which do cover preheating or, at least, are reasonably susceptible of such a construction.

Warth relied upon the claims of the parent patent as affording a monopoly sufficiently broad to exclude others from using preheating, as shown by notice to Johnson and respondent of infringement of the parent patent as soon as their use of preheating became known.

Moreover, there was no delay by Warth in asserting his prior inventorship of preheating after Johnson's patent with specific preheating claims came to Warth's attention. As pointed out *ante*, p. 9, if, through oversight, the Patent Office had not failed to declare an interference between the Johnson application and Warth's original application, the question of priority would have been determined in the manner provided by the Statute and the Patent Office Rules while Warth's *original* application was pending. Warth would, by such interference, have had actual notice of the necessity for presenting specific preheating claims since such claims then stood allowed in the Johnson application (R. pp. 712, 717).

In *Chapman v. Beede*, 296 Fed. 956, 959, (App. D. C.), where there had been a similar oversight on the part of the Patent Office in declaring an interference, the Court recognized that the applicant was entitled to the benefit of the equitable maxim that the Courts view as done what ought to have been done and excused a delay of more than two years because the inventor had previously claimed substantially the same invention. Warth, like the inventor in the *Chapman-Beede Case*, in presenting the specific claims was simply covering what he had originally disclosed and claimed broadly, without any intent to expand his disclosure to cover later methods which had come to his attention. By making such specific claims, when the Johnson patent came to his attention, Warth immediately obtained an interference with the Johnson patent so that the Patent Office would have opportunity to correct its mistake.

Clearly Warth should not be penalized for delay directly traceable to this Patent Office oversight.

This Court, in *Chapman v. Wintroath supra*, appreciated the inequity of penalizing an inventor whose delay in presenting claims is attributable to a Patent Office failure to declare an interference with an inadvertently issued patent. The Court said (pp. 138, 139):

“But when a conflict between inventions disclosed in applications *escapes the attention of the Patent Office Examiners*, Rev. Stats., Sec. 4904, and a patent is issued, with claims conflicting with the disclosures of a pending application, the applicant receives only such notice of the conflict as he is presumed to derive from the publication of the patent. In the one case the notice is actual and specific, in the other it is indefinite and constructive only. When the great number of patents constantly being issued is considered, many of them of a voluminous and complicated character, such as we have in this case, with many and variously worded claims, such an implied notice must necessarily be precarious and indefinite to a degree which may well have been thought to be a sufficient justification for allowing the longer two-year period to inventors who

must, at their peril, derive from such notice their knowledge of any conflict with their applications."

While Warth might have made claims specific to preheating in his original application, he should not be charged with lack of diligence in failing to do so until he had notice, as by issuance of the Johnson patent, of any reason to present specific preheating claims.

We submit that, in view of the foregoing, the Court of Appeals should have excused Warth's delay and held the divisional patent valid.

POINT V.

The Grant of the Divisional Patent is Not Inconsistent with a Broad Interpretation of the Parent Patent Claims.

The reason assigned by the Court of Appeals for adopting a limited construction of the parent patent claims was (R. p. 1836):

"To read them to mean a cold punch which positions the spot on a preheated cork would be inconsistent with the fact that the preheating specification was deliberately divided out and later claimed in Warth's 'preheating patent' hereafter to be discussed".

The above-quoted statement apparently overlooks the fact that a customary procedure when protecting by a separate divisional application, a divisible part of what is disclosed in an original parent application, is to cancel the disclosure of that part from the parent application when it is embodied in the separate divisional application. As the District Court said (R. p. 1800), the Warth divisional patent subject-matter

"was specifically reserved by continuous inclusion in the divisional application and later in the second division. This has been approved and is the usual practice. Writer v. Kiwad, 63 Fed. (2d) 259."

The Court of Appeals obviously overlooked the fact that the two patents have a logical and valid relationship when

the claims of the parent patent are broadly construed. In other words, the parent patent claims cover broadly *any* way of applying heat simultaneously with pressure to the spot at the instant the spot is deposited upon the cork. The hot punch is illustrated as one suitable means for doing this. When the parent patent expires, the public will be free to use any method involving the use of heat simultaneously with pressure at the instant of assembly *except* the specific way (preheating) claimed in the divisional patent. The divisional patent, therefore, does not extend the parent patent monopoly, as respondent has suggested.

This relationship between the two Warth patents is the one which usually exists between broad parent and specific divisional patents. Therefore, the District Court (R. p. 1804) correctly said:

"None of the claims of the divisional patent is readable upon the disclosure of the reissue, and therefore when the Reissue Patent expires, the public will be free to practice the method without infringing the divisional patent, that is, the public may employ any method of obtaining the heat at the instant of assembly except the specific 'heating the pads in the caps' covered in the later patent.

"The Reissue Patent is the generic and the divisional the specific patent, and therefore the reissue does not anticipate the divisional patent."

POINT VI.

The Court of Appeals Should Have Found that Respondent Infringes the Claims of the Warth Parent Patent.

The Court of Appeals did not suggest that the parent patent claims would be anticipated by the method of petitioner's slide machine (Appendix, pp. 41, 42) or by other prior art if the claims were construed to cover preheating. As we have already shown, it narrowly construed the claims only because of (a) certain inferences drawn from proceedings in the prosecution of the parent patent, and (b) a misreading of the language of the parent patent claims.

We have shown that there is nothing in the patent file which precludes the interpretation for which we contend and that the language of the claims applies clearly to a method in which the heat is obtained *either* from the punch or from a heated cork.

Referring to the claims, the Court of Appeals said (R. p. 1836):

“To read the claims of the reissue patent to mean a cold punch to cut the spot and a hot plunger applied later to fasten it to the cork disc would make them invalid under the old ‘slide machine’.”

We admit that the claims do not cover a cold punch for cutting the spot *unless in the same operation heat and pressure are simultaneously applied to the spot*. Petitioner has never asserted, nor is there anything in the record to suggest, that the claims read upon the use of a cold punch followed by the application of heat by a hot plunger *later or at another station*. Consequently, this alternative procedure proposed by the Court has no bearing on any issue in the case.

But the important point is that the Court did not find that the claims would be anticipated *if construed to cover the simultaneous use of heat and pressure at the instant of assembly, whether the heat comes from the punch or from the cork*. Therefore, the Court of Appeals did not reverse the holding of the District Court that the claims, if construed as they read, would be valid over the prior art.

We submit that the construction of the claims adopted by the District Court was correct, since it is the only interpretation which is consistent with the claim language and with the evident intent of the patentee as shown by his conduct in the prosecution of his parent patent (1,788,260) and after the grant of the patent. Moreover, it is the only interpretation which secures to the patentee protection for his real invention.

The Court of Appeals found (R. p. 1837) that respondent infringes the claims of the divisional patent and since those claims are merely for a *specie* (preheating) of the invention claimed in the parent patent, this is the equivalent of a finding of infringement of the parent patent, if the claims thereof be construed as petitioner contends. Respondent uses the spotting method of the Johnson patent (R. p. 575). As the Court of Appeals said (R. p. 1835, footnote), respondent uses a cutting punch which, by radiation from adjacent "preheater" and "post heater" plungers, has a temperature of approximately 140° F. Respondent *also* heats the cork. Thus, respondent applies the heat to the spot at the instant it is assembled; partly from the punch and partly from the cork. The fact that respondent, in addition to using a heated punch, also employs a heated cork to render the adhesive tacky, certainly does not avoid a patent which initially described the use of the heated cork and thereafter illustrated the heated punch as *another* example. Respondent simply chose to use *both* the punch and the cork as sources of heat, instead of a single source. Although the heat (140°) in respondent's punch alone might not suffice for efficient operation, respondent certainly makes use of a heated punch, and to this extent employs the invention of the Warth parent patent claims, even as limited by the Court of Appeals.

The claims should be accepted as they read and are valid. The District Court so found and clearly pointed out (R. pp. 1785-87; 1789-90) how the claims, construed as petitioner urges, distinguish from the prior patent art, as well as petitioner's old "slide" machine method.

CONCLUSION.

It is submitted that the decree of the Court of Appeals should be reversed and that this Court should hold:

1. That the doctrine of *Webster v. Splitdorf* applies only where there have been intervening adverse rights more than two years prior to the filing of a divisional application

and, in the absence of such intervening rights, no excuse for delay in presenting the claims in a divisional application is required.

2. That, even if an excuse be required for Warth's delay in presenting his divisional patent claims, the record shows an adequate excuse in that the parent patent claims are, in fact, or at least seemingly, of sufficient breadth to dominate the "preheating" method of the divisional patent and Warth reasonably relied upon the claims as being of such scope.

3. That the claims of the Warth divisional patent are valid and infringed.

4. That the claims of the Warth parent reissue patent are valid and infringed.

Respectfully,

THOMAS G. HAIGHT,

GEORGE F. SCULL,

JOHN J. DARBY,

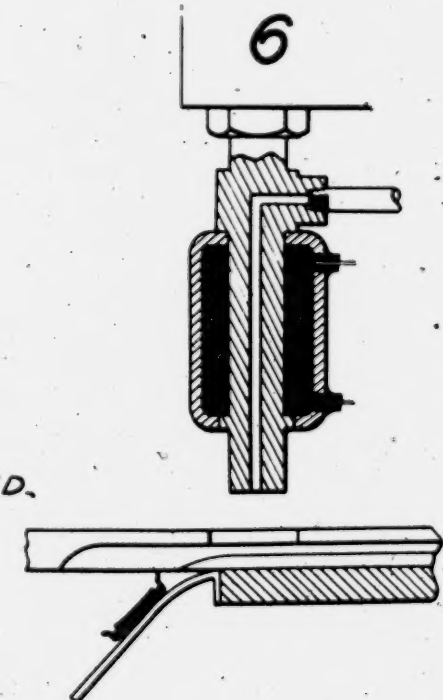
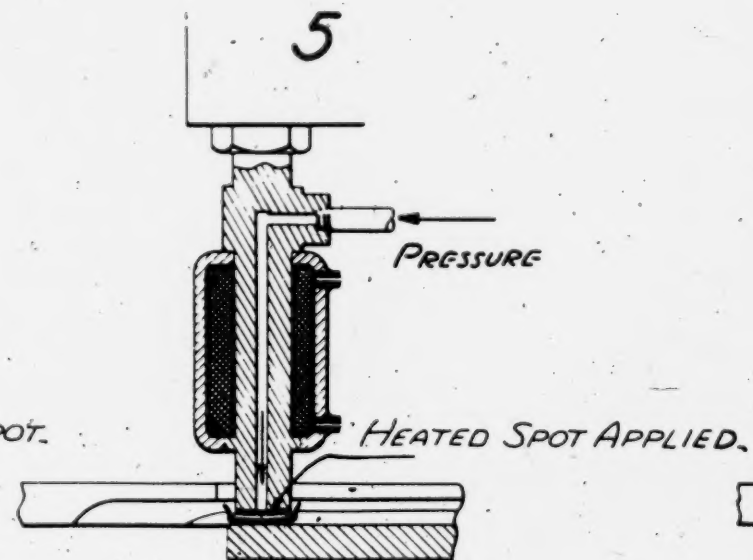
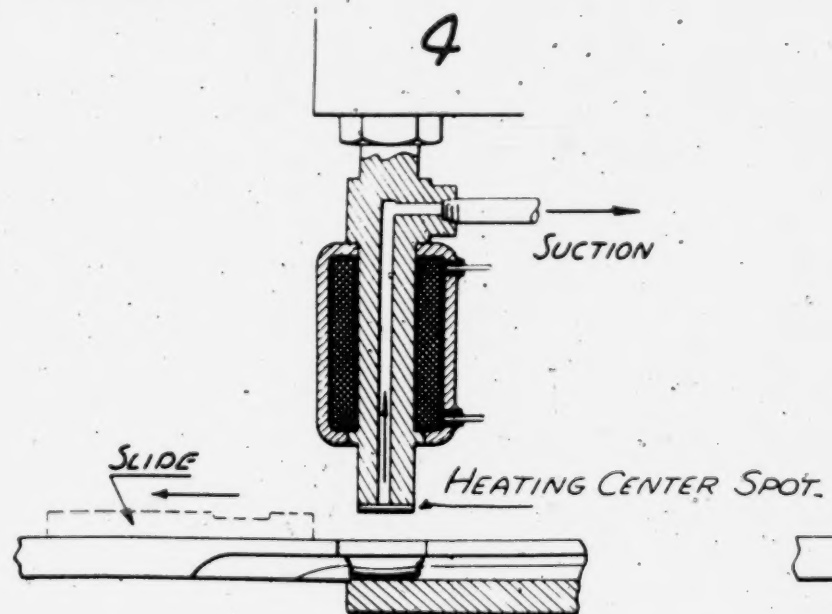
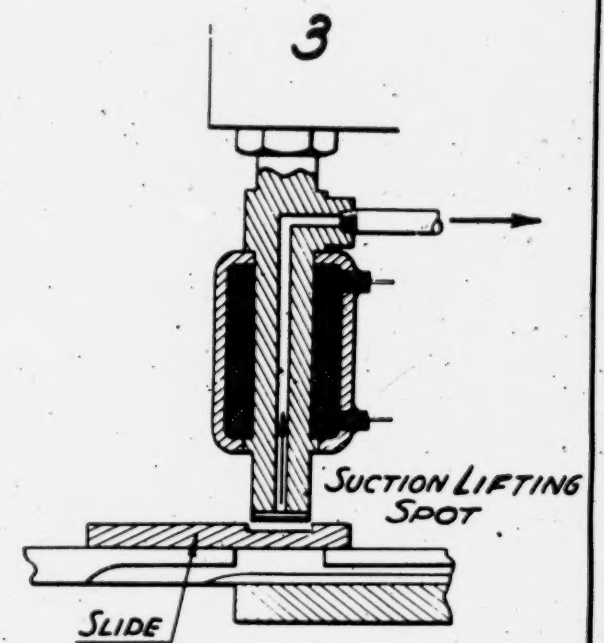
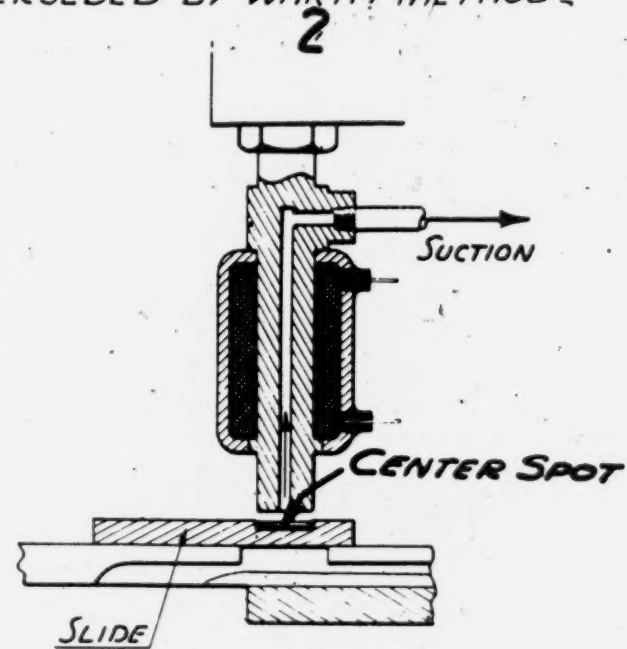
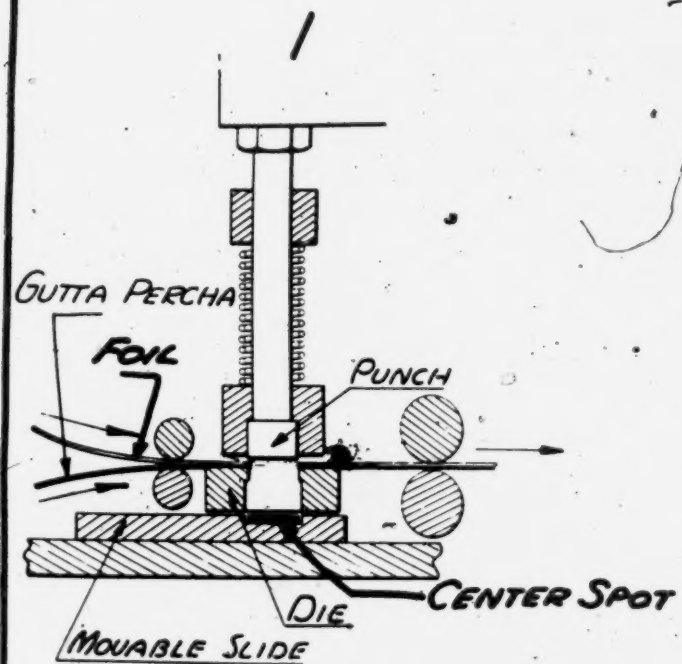
GEORGE W. PORTER:

Counsel for Plaintiff-Petitioner.

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PETITIONER'S "SLIDE" METHOD.
SUPERSEDED BY WARTH METHOD.



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APPENDIX.**Petitioner's Old "Slide" Machine.**

The operation of this machine, as disclosed by contemporaneous description and photographs (R. pp. 613, 614A, B), is illustrated by the drawings opposite this page. Separate strips of tin foil and gutta percha tissue were fed, one over the other, beneath a cutting punch which cut out a disc from each strip and deposited them in a cavity in a movable slide. Then the slide moved horizontally, carrying the cut-out discs beneath an electrically heated suction plunger which, by its suction, lifted the two discs from the slide cavity and held and heated them while a crown shell containing a cork cushion was being moved beneath the plunger and the slide was being withdrawn. Then the plunger descended with the already-heated spot and pressed it against the crown, the suction being changed to pneumatic pressure, which blew "the spot from its position * * * onto the crown" (R. p. 613). The crown was then ejected from the machine.

The Warth Method and Slide Machine Differ Essentially.

Claim 3 of the Reissue patent quoted in the footnote (p. 4, *ante*) specifies the essential differences between the Warth method and the method involved in petitioner's old slide machine, over which, as the District Court said, "the [Warth] method has great advantages" (R. p. 1785). The District Court (R. p. 1790) found that:

"The combination of steps defined in the Warth methods of the patents in suit are not found in the plaintiff's first or slide machine, and it does not anticipate".

The Court of Appeals did not disagree with this, but construed the claims of the parent patent narrowly because of certain inferences which it drew from occurrences during the prosecution of the application for the Warth parent patent.

The method as defined in the claim covers the combination of all the steps and specifies the stage at which the heat is applied *to the spot*. The claimed method involves the following:

First, a strip coated with thermoplastic adhesive is positioned beneath a punch and over a crown. (The slide machine used *separate* strips of tinfoil and gutta percha).

Second, the punching operation is utilized to deposit the spot upon the crown in central position. (The punch in the slide machine deposited the gutta percha and foil discs in a slide).

Third, heat and pressure are utilized simultaneously upon or at the instant of assembly, to adhere the spot. (In the slide machine the discs were lifted from the slide and heated *before deposit* on the crown).

Fourth, the crown is cooled under pressure (claim 3). (There was no pressure on the crown during cooling in the slide machine).

While each of the steps is vital, as petitioner's witness puts it (R. p. 67):

"This last [Third, *supra*] step of applying both heat and pressure instantly with assembling serves the useful purpose of positioning the center spot centrally in the cap and enables it to stay put until further operations can be performed. This must be done instantly. Where you are running a machine at 500 per minute there is no time to wait, and one must be sure that the spot is centrally positioned.

"The use of heat and pressure instantly with deposit of the spot might be considered the keynote of the entire operation. However, the three steps are like, I might say, the three steps of a tripod. Without any one of these steps the method will not function".

In the slide machine, none of the steps above described was performed. The spot was not punched over the crown. The punching operation was not used to deposit the spot on the crown. The heat was applied to the spot *before* it was assembled with a crown, *i. e.*, by a hot plunger which

lifted it from the slide and held the spot for heating while the slide was withdrawn and while a crown was positioned beneath the plunger. Finally, in the slide machine there was no cooling of the spot under pressure. As a result, the speed of production was very slow and defective crowns were frequent (R. p. 370).

U. S. C., Title 35; Sec. 52 (R. S. Sec. 4904).

“Whenever an application is made for a patent which, in the opinion of the commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, within such time, not less than twenty days, as the commissioner shall prescribe.”

Rule 96—Rules of Practice in the United States Patent Office.

“96. Whenever the claims of two or more applications differ in phraseology, but relate to substantially the same patentable subject matter, the examiner shall suggest to the parties such claims as are necessary to cover the common invention in substantially the same language. The examiner shall send copies of the letter suggesting claims to the applicant and to the assignee, as well as to the attorney of record in each case. The parties to whom the claims are suggested will be required to make those claims within a specified time in order that an interference may be declared. Upon the failure of any applicant to make any claim suggested within the time specified, such failure or

refusal shall be taken without further action as a disclaimer of the invention covered by that claim unless the time be extended upon a proper showing. After judgment of priority the application of any party may be held for revision and restriction, subject to interference with other applications.

Whenever it shall be found that two or more parties whose interests are in conflict are represented by the same attorney, the examiner shall notify each of said principal parties and also the attorney of this fact."

U. S. C., Title 35, Sec. 31 (R. S. Sec. 4886).

"Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtained a patent therefor."

U. S. C., Title 35, Sec. 33 (R. S. Sec. 4888).

"Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding and using it, in such full, clear, concise,

and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor. No plant patent shall be declared invalid on the ground of noncompliance with this section if the description is made as complete as is reasonably possible."

Claim 35 (R., p. 925) of the Johnson Application Which Was Not Suggested by the Patent Office to Warth for Interference Purposes as it Should Have Been Under the Statute and Rule (Appendix, p. 43 ante.)

"35. The method of assembling linings for sealing pads in receptacle closure caps, consisting in providing caps with sealing pads assembled therein and a web of lining material having an adhesive surface non-viscous at normal temperature, severing linings from the web of lining material and assembling the linings as they are severed from the web in the caps with the adhesive surface in contact with the pads, then placing the linings in the caps under heat and pressure to render the adhesive viscous and effect an intimate contact between the linings and pads."

Utah Radio Corp. Products Co. v. Boudette (C. C. A. 1st), 78 F. (2d) 793.

The Court, stating the facts of the Webster case, pointed out that the subject-matter of the divisional claims had been disclosed in a Podlesaks patent issued over five years before the claims were first presented and had been in public use by others than the patentee for over five years.

The court said (at p. 799) after referring to the Webster case, that claims may "reasonably" be presented at any time within two years after the adverse public use:

*"In that [Webster] case the court applied by way of analogy the statutory two-year period of prior publication and public use * * *."*

"There the subject-matter of claims 7 and 8, though not claimed in the Podlesaks patent, was disclosed by it, and, consequently, on the issuance of that patent in 1913, was published and given to the public.

"In the case now before us, the subject-matter of claims 1, 2, and 5 here in issue was known and *in public use* through the sale of RCA loudspeaker 104 in November, 1925, some four years before claims 1, 2 and 5 were asked for, whereas they reasonably *could have been inserted* in the original application of April, 1926, or at *any time thereafter up to two years from November, 1925*, but were not until October 17, 1929, when the divisional application was made."

Wagenhorst v. Hydraulic Steel (C. C. A. 6th) 27 F. (2d) 27, 29.

The Court (Denison, J.,) after reciting the facts of *Webster v. Splitdorf*, said with reference to that case:

"From the recitals and reasoning of the [Webster case] opinion, we are unable to see that the fact that the amendment of 1918 was presented in a divisional application, instead of an original application, was of any importance to the result reached. The long delay which elapsed between the original and the divisional was important, *not because it was the interval between these two applications, but because it extended so long after the 1913 public disclosure*. If the original application of 1910 had not matured into a patent in 1916, but had continued pending, and the amendment in 1918 had been offered in that original application, and the facts had been otherwise the same, we see nothing in the opinion, and no reason occurs to us, which would indicate a different result. In other words, claims 7 and

8 were invalid *because*, in an effort to broaden any previous statements of the invention, *they were first presented by an amendment offered five years after their subject-matter had been disclosed to the public by the Podlesaks patent*; and such an effort to broaden the claim of invention was, by analogy to the reissue rule, barred by laches, estoppel, and intervening rights. In the present case the divisional application was filed promptly after the intervening device appeared, and the Webster Case does not apply."

Wirebounds Patents Co. et al. v. Saranac (C. C. A. 6th), 37 F. (2d) 830, 840, 841.

The District Court had held the patent in suit invalid under the ruling in the Webster case. The Court of Appeals (Denison, J.,) discussing the *Webster* case reversed the District Court and said:

"This [District Court decision] was before we had by our *Wagenhorst Case*, * * * adopted our interpretation of the *Splitdorf* decision." * * *

"This case is plainly not within the *Splitdorf* rule, as we understand it, either by parallelism or by strict analogy. Defendant points out, as a general analogy, that the machine and method had been in public use by the applicants, who became the patentees, and under licenses from them, all for more than two years before the divisional application was filed. This is true. When it is remembered that the divisional application is normally entitled to the benefit of the original filing date, it is not easy to see how public use under license from the applicants can amount to that laches under which adverse rights may arise; or how the *Splitdorf* rule can apply unless the delay is after the public appearance of an adverse claimant, or, perhaps, one who may be an adverse claimant; but we find it unnecessary to decide that question".

**Wirebounds Co. v. Saranac (C. C. A. 6th), 65 F. (2d)
904, 905, 906.**

"In view of the circumstances above mentioned, the cases of Webster Electric Co. v. Splitdorf Electric Co., 264 U. S. 463, 44 S. Ct. 342, 68 L. Ed. 792, and Chapman v. Wintroath, 252 U. S. 126, 40 S. Ct. 234, 64 L. Ed. 491, while dealing with one phase of laches and delay, are not precisely in point, for in them the making of amendments, the copying of claims for interference purposes, or the filing of divisional applications, was necessitated by the issue of a patent to another inventor, which patent wholly or partially covered the same ground as the pending application, and the sole purpose of the then applicant was to obtain a patent in terms broad enough to cover that already issued. These two cases held that, in analogy to the existing limitation upon a right to reissue, unexplained delay and neglect upon the part of an applicant, for more than two years, in bringing forward claims broader than those originally sought, that is, *a delay of more than two years after the issue of the other patent*, constituted laches by which the applicant lost whatever rights he might otherwise have had. Both cases had reference to interfering patents in respect of the same subject-matter. This we do not find in the present case, but the two cited cases are interesting as showing one set of circumstances in which rights which might otherwise have existed may be forfeited by laches."

**Hopfelt v. Read, 190² Commissioner's Decisions,
319, 320, 321.**

"The disclosure in the original application is identical with the disclosure in the later application involved in this interference. The interference is the same as though the earlier application had been included in place of the later one. The reason that the earlier application was not included was due to the fact that under the practice of the Office the claims could not be made therein and it was necessary to file a divisional application. * * *

“This is so when two applications are pending contemporaneously and the first is not abandoned, whether the claims are presented in the original application itself or in a later application filed as a division or a continuation of the original application, as in the second case the later application dates back to the earlier one. *It is only necessary that the description in both applications shall be sufficient to support the claims. The fact that the Office practice may prohibit the prosecution and allowance of the claims in an earlier application does not prevent an applicant from availing himself of the earlier date of filing as his date of constructive reduction to practice when he files a later application containing the same description and the claims based upon the same.*”

See also *Von Recklinghausen v. Dempster*, 34 App. D. C. 474, 476, 477, and *Forbes v. Thomson*, 1890, Commissioner's Decisions, 61, 63.